



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,189	07/14/2005	Shiro Kanegasaki	1752-0172PUS1	2696

2292 7590 05/27/2009  
BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
----------

EDWARDS, LYDIA E

ART UNIT	PAPER NUMBER
----------	--------------

1797

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

05/27/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/542,189	<b>Applicant(s)</b> KANEKASAKI, SHIRO	
	<b>Examiner</b> LYDIA EDWARDS	<b>Art Unit</b> 1797	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-7 and 17 is/are rejected.
- 7) ☒ Claim(s) 5 and 8-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Continued Examination Under 37 CFR 1.114**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/14/2009 has been entered.

### **Response to Arguments**

Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4, 6 and 17 rejected under 35 U.S.C. 102(b) as being anticipated by Kricka et al. (US 5744366).

Regarding Claims 1, 4, 6 and 17, Kricka et al. ('366) teaches an apparatus for detecting chemotaxis of cells which comprises: a cell-holding well having an opening for injecting cells [32]; a specimen-holding well having an opening for injecting a specimen [22]; a channel which connects said cell-holding well and specimen-holding well up with each other and has resistance to the passage of cells [20 and 24], and which detects chemotaxis of cells by observing a passage of cells in said channel from said cell-holding well to said specimen-holding well caused by a concentration gradient of said specimen formed in a stationary liquid in said channel; a means of

Art Unit: 1797

transporting said liquid from said cell-holding well [110] to said specimen-holding well by an injection or an aspiration discharge of said liquid and then stopping the transportation of said liquid after said injection or said aspiration discharge of said liquid in order to control a position of each cell in said cell-holding well; and a means of sealing said opening(s) in one or both of said cell-holding well and said specimen-holding well [30a and 30b] for preventing said liquid from an unexpected transportation thereof in said channel while detecting chemotaxis of cells (Col 3, lines 48-54; Col 11, line 5-Col 12, line 17; Figure 1).

Regarding Claim 2, Kricka et al. ('366) teaches wherein said means of transporting a liquid and stopping the transportation thereof is a member selected from a syringe (Col 11, lines 22-27; Figure 1 [110]).

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

Art Unit: 1797

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kricka et al. (US 5744366).

Regarding Claims 3 and 7, Kricka et al. ('366) discloses the use of a sealing tape or another type of sealant as a means of sealing the opening (Col 11, lines 53-60).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute one known means of sealing for another, since the examiner takes Official Notice of the equivalence of sealing means of the instant application and that of Kricka for their use in the sealing art and the selection of any of these known equivalents to seal an opening would be within the level of ordinary skill in the art.

#### **Allowable Subject Matter**

Claims 5 and 8-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding Claims 5 and 8, prior art does not teach or suggest wherein said cell-holding well and said specimen-holding well are connected via an injection pipe joined to said cell-holding well, an aspiration discharge pipe joined to said specimen-holding well and said means of transporting a liquid including the limitations set forth in any one of claims 1-3.

Regarding Claims 9-16, prior art does not teach or suggest wherein said cell-holding well having an opening for injecting cells and a specimen-holding well having an opening for injecting a specimen which are formed by a substrate having a raised bank in the middle thereof and a glass substrate and are divided into each other by said raised bank.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LYDIA EDWARDS whose telephone number is (571)270-3242. The examiner can normally be reached on Mon-Thur 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571.272.1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LYDIA EDWARDS/

Examiner

Art Unit 1797

LE

/Walter D. Griffin/  
Supervisory Patent Examiner, Art Unit 1797